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CHARLES ELMORE CROPLEY

IN THE

Supreme Court of the United States

October Term, 1944

No. 656

SINCLAIR & CARROLL COMPANY, INC.,
Petitioner,

v.

INTERCHEMICAL CORPORATION,
Respondent.

REPLY BRIEF FOR PETITIONER

WILLIAM D. MITCHELL,
Attorney for Petitioner.

WALTER H. FREE,
MARK N. DONOHUE,
Of Counsel.

307 BAR PRESS, INC., 47 WEST ST., NEW YORK. NO. 9—0157 - 8

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Respondent's brief questions some statements of fact made by petitioner, and makes some statements which we think should be questioned.

The only purpose of this memorandum is to deal with those matters.

1. In attacking the District Court's findings, respondent asserts (Brief, p. 9):

> "One finding, that as to non-infringement, was directly contrary to a ruling made by the district judge after a full argument during the trial (I, pp. 239-244)."

Respondent's reference is to the District Court's denial of the usual motion to dismiss the complaint at the close of a plaintiff's *prima facie* case. The District Judge merely denied the motion without comment or "ruling" (I, p. 244).

Evidence refuting the charge of infringement was thereafter presented in petitioner's case, including the proof that the new flame type heater, as developed in 1937, made possible the use of low volatility inks like petitioner's, with a solvent vapor pressure as low as 20 mm. at 150° C. (I, p. 551). *That fact alone was enough to show that Gessler, when he used the term "approximates" 40 mm. had no conception that an ink with 20 mm. solvent vapor pressure at 150° C. could be used.* It was persuasive proof that he did not himself consider that an ink with 20 mm. solvent vapor pressure at 150° C. was an ink with a solvent vapor pressure approximating 40 mm. at 150° C.

2. Respondent states (Brief, p. 14):

> "By ignoring the proof showing that heating devices had long been used on printing presses, the petitioner can assert that the information which Mr. Cray gave Gessler as to this feature of the prior art was the real basis of the invention."

Petitioner has not ignored proof showing that heating devices had long been used on printing presses. The fact is that there is no proof that heating devices had been *used* on printing presses of the kind with which Gessler was concerned prior to the time Cray suggested the use of such heating devices to Gessler in 1932 (I, pp. 73, 706-709). In each instance referred to in the record, of the first use of heat drying ink, the press had to be altered to equip it with a heater: Paterson Parchment Paper Co. (I, p. 74), Conde Nast Press (I, p. 154), W. F. Hall Co. (I, pp. 513, 515, 551), R. R. Donnelly & Sons (I, pp.

588-590, 605-606), Kalamazoo Vegetable Parchment Co. (I, pp. 190, 195), Benjamin C. Betner Co. (I, p. 614).

Prior to Cray's suggestion, in 1932, to use a heater on the press, low temperature heating equipment, such as steam drums or rollers, had been used on rotogravure presses, and the idea of using heat was suggested to Cray by the rotogravure practice. To use Cray's words (I, p. 97):

> "I had often thought of that, because there was a big rotogravure company in the same offices, and it used to break my heart to go down and see them dry by going over some drum."

but no such heating equipment was used on ordinary fast printing presses so far as this record shows.

Furthermore, respondent misses the point.

The flame type heater, developed in 1937, which brings the printed paper in close proximity to an actual flame, made possible the use of an ink, like petitioner's, with a solvent having a vapor pressure at 150° C. as low as 20 mm. (I, pp. 550-551). When interpreting the word "approximates" in the claims, and deciding whether petitioner's ink with 20 mm. solvent vapor pressure at 150° C. "approximates" one with 40 mm. solvent vapor pressure at 150° C., the interpretation should be made in the light of the available knowledge at the time the claims were drawn. If Gessler had no idea that an ink containing a solvent of 20 mm. vapor pressure could be used, is it not conclusive that he did not draw his claims to cover such an ink?

3. Respondent states (Brief, p. 17):

> "Actually petitioner's ink, like that described in the patent, dries instantly at 150° C. This is conclusively proved by demonstrations in Court (I, pp.

32-40, 51), and by commercial use of the ink on the same press on which the patented ink had been used" (I, pp. 237-238).

This statement is erroneous as to both stated sources. There was no demonstration in Court or elsewhere that petitioner's ink "dries instantly at 150° C." The record is barren of such proof. The Court demonstrations made were with alcohol and butyl acetate, both evaporating rapidly at room temperature (I, pp. 33-35). Neither is used in petitioner's ink. At Record page 51, plaintiff's expert, Bragdon, merely expressed the opinion, without demonstration, that defendant's "502C" solvent "would evaporate at just about the same rate at 150 degrees Centigrade, as Exhibit 9" (butyl acetate). As butyl acetate evaporates rapidly at room temperature, it will all have disappeared long before the temperature of 150° C. is reached. The record shows that defendant's ink is dried in flame type ovens having temperatures as high as 500°-1000° C. (I, pp. 550, 505), far above the 260° C. (500° F.) temperature which Gessler's patent file wrapper stated "is much higher than that which could be used in the successful operation of applicant's process" (II, p. 840).

4. Respondent states (Brief, p. 2):

> "High speed rotary printing presses, like those used today, were in general use for at least thirty years before 1932. They were used solely for printing on soft, absorbent paper, like newspaper. They could not be used for high-grade printing on smooth paper because there was no printing ink which could be instantly dried. Attempts to do high-grade printing on high speed presses began at least as early as 1917 and were all failures up to 1932."

Before 1932, high speed rotary presses were used successfully "on softer papers, more absorbent papers, print papers and E. G.'s, English finishes". Heat drying inks made the printing operation "Somewhat speedier * * *. There is some increase in production" (I, p. 601). Even today the proportion of linseed oil ink (which respondent infers has been replaced by Gessler's heat drying ink), is still far greater than the amount of heat drying ink sold (I, p. 227).

5. Respondent states (Brief, p. 6):

> "The court tests proved that both butyl acetate and toluol have substantially the same volatility as alcohol (I, pp. 662-666). Thus, the highly volatile solvents of which alcohol is typical, have vapor pressures which approximate that of alcohol within a few centimeters * * *" (and at top of page 8): Petitioner's solvent "at the high temperature mentioned in the claims (150° C.) [it] has a vapor pressure of 2 cm. (20 mm.) which is equal to that of the liquid, toluol, which has the same volatility as the typical highly volatile liquid, alcohol * * *."

The utter unreliability of the "court tests" referred to is evident from the record (I, pp. 662, 665, 666), where it is shown that, in the crude tests applied by respondent's expert, toluol, having ½ the vapor pressure of alcohol, evaporated *faster* than alcohol, despite the fact that this same expert had previously testified (I, p. 58) that alcohol evaporates at room temperature at a faster rate than water, because alcohol has a higher vapor pressure than water at room temperature.

6. Respondent states (Brief, p. 7) that:

> "the patented ink had gone into extensive use" when petitioner's ink appeared on the market (in 1938).

This statement begs the very issue upon which it is based. The question is whether respondent's patent covers the commercially successful petroleum solvent inks, of which petitioner's ink is one.

The butyl carbitol ink described in the patent was a commercial failure. Only 30,000 pounds have been sold over a period of three years and its sale virtually stopped in 1936 (I, pp. 225, 226, 951). It cannot be used on the usual high speed presses because of its damaging effect upon the inking rollers (I, pp. 91, 92, 121, 142; II, pp. 766, 767). The really commercially successful heat drying inks, which use a petroleum solvent (I, pp. 88, 89), were first introduced in 1933 at Curtis Publishing Company by Fred'k H. Levey Co., four years before Gessler's patent issued (I, pp. 82-84, 586). Levey, also in 1933, purchased the Doughty heat-drying ink patents (I, p. 694; II, pp. 1021-23), which disclosed the petroleum solvents then and now used in the commercially successful heat-drying inks, and which expired in 1939 (II, p. 962, ll. 16-20; I, pp. 292-295, 299-304).

7. The respondent (Brief, p. 13) criticizes Kerley's testimony that (I, p. 551):

> "without an oven you could not run any of them" (the commercial heat drying inks using petroleum solvents, such as petitioner's) and that the "first good oven" was put into operation "about 1937."

Kerley's testimony stands uncontroverted on the record. There is not one word of testimony indicating that a petroleum solvent ink could be used successfully with the low temperature steam drum type dryer suggested by Cray to Gessler in 1932 (I, pp. 73, 707-709). The only type of ink solvent that Gessler found could be used with that steam drum or roller type of drying equipment was butyl carbitol (I, pp. 707, 720). Even then, as the experience

with the Paterson Paper Parchment Co. test shows, the steam drum type dryer damaged the paper (I, pp. 89, 90). Petroleum solvent inks, like petitioner's, require the new flame type heating equipment as developed in 1937 for successful use (I, p. 551).

Respectfully submitted,

WILLIAM D. MITCHELL,
Attorney for Petitioner.

WALTER H. FREE,
MARK N. DONOHUE,
Of Counsel.